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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,780	08/14/2001	Koichi Kawana	450100-03413	9015
20999	7590	09/21/2006	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			WILDER, PETER C	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/929,780	<b>Applicant(s)</b> KAWANA ET AL.	
	<b>Examiner</b> Peter C. Wilder	<b>Art Unit</b> 2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/3/2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1 and 10 are amended

Claims 2-4, 6-9, 11-12, and 14-16 are original/previously presented

Claims 5 and 13 are canceled

#### ***Note to Applicant***

Art Units 2611, 2614 and 2617 have changed to 2623. Please make all future correspondence indicate the new designation 2623.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-4, 6-8 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Priority***

The applicant argues on page 10 that the reference Bowser (U.S. 6870570) is invalid because its priority date Oct. 31, 2000 does not proceed the foreign filing date of the application August 16, 2000.

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 (dependent on claim 9) still is vague because it calls for a portable terminal comprising an electronic apparatus and the electronic apparatus includes the portable terminal. It is not clear if the portable terminal includes the electronic apparatus or the electronic includes the portable terminal.

To expedite the review of the application the claims will still be evaluated against prior art.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. 20050028208 A1) in view of Liebenow (U.S. 6601074 B1) further in view of Young et al. (U.S. 2005/0251836 A1) further in view of Herrod et al. (U.S. 6405049 B2) further in view of Pope (U.S. 5963624) further in view of McKenna et al. (U.S. 6594498 B1).

Referring to claim 1, Ellis teaches a broadcast program recording and playing apparatus (Figure 2a) comprising:

program management means for managing a database that stores program information for broadcast programs (Paragraphs 69 and 70 teaches a user television equipment receiving program guide data; and paragraph 82 teaches the program guide running on the set-top box and being stored in memory in the set-top box thus the set-top must manage the storing of the program guide data);

transmission means for transmitting the program information stored in the database to an electronic apparatus using wireless communication (Paragraph 71);

Ellis fails to teach control means for controlling, recording and playing broadcast programs in accordance with received selection information; determination means for determining whether the selection information indicates information that has been recorded by the apparatus having functions of recording and playing broadcast programs and for designating a point for which to begin playback; switching means for switching a wireless communication unit between communication using a public circuit

based on a spread spectrum communication system and short-distance wireless communication based on the spread spectrum communication systems.

In an analogous art Liebenow teaches control means for controlling, recording and playing broadcast programs in accordance with received selection information (Column 5 lines 1-7 teaches a user selecting or choosing to record a program with a remote control element 215 in Figure 2 which send selection information to a receiving device system 100, Column 3 lines 46-57);

determination means for determining whether the selection information indicates information that has been recorded by the apparatus having functions of recording and playing broadcast programs (Column 5 lines 26-45 and Figure 3 teaches the system checking recording information to determine if the program has been recorded or not).

At the time the invention was made it would have been obvious for one skilled in the art to modify the wireless remote apparatus of Ellis with the determination of recorded information apparatus of Liebenow for the purpose of freeing a user from having to research the contents of each episode of a program in order to determine whether has already recorded that particular episode and then having to selectively program his system for each occurrence of the programs that he wishes to record (Column 2 lines 7-12, Liebenow).

Ellis and Liebenow fail to teach designating a point for which to begin playback; switching means for switching a wireless communication unit between communication

using a public circuit and short-distance wireless communication and using spread spectrum in wireless communication.

In an analogous art Young teaches designating a point for which to begin playback (Paragraph [0128] teaches storing the location of recorded information on a video tape and telling the tape to start playing from a certain position when a program is selected).

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined apparatuses of Ellis and Leibenow with the playback location designation apparatus of Young for the purpose of allowing for easy retrieval of recorded programs on a video tape.

Ellis, Liebenow, and Young fail to teach switching means for switching a wireless communication unit between communication using a public circuit and short-distance wireless communication and using spread spectrum in wireless communication.

In an analogous art Herrod teaches switching means for switching a wireless communication unit between communication using a public circuit and short-distance wireless communication (Column 16 lines 20-30 and Column 39 lines 66-67 and Column 40 lines 1-5).

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined apparatuses of Ellis, Liebenow, and Young with the wireless switching between private and public networks apparatus of Herrod for the

purpose of providing guaranteed communications no matter where the device is located in relation to the terminal (Column 16 lines 26-30, Herrod).

Ellis, Young, Liebenow, and Herrod fail to teach using spread spectrum in a wireless public and short distance wireless communication system.

In an analogous art Pop teaches using spread spectrum in a short distance wireless communication system (Column 2 lines 52 – 57 teaches using spread spectrum communication to control appliances)

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined apparatuses of Ellis, Liebenow, Young, and Herrod with the spread spectrum communication apparatus of Pope for the purpose of being able to communicate from a different room and or a significant distance away from the base unit 12 (Column 3 lines 24-28).

Ellis, Liebenow, Young, Herrod, and Pope fail to teach using spread spectrum in a wireless public communication system.

In an analogous art McKenna teaches using spread spectrum in a wireless public communication system (Column 5 lines 63-67, Column 6 lines 1-18, and Figure 1B teaches a wireless system using CDMA (which is a form of spread spectrum) and Column 3 lines 37-44 teaches multiple customers and a customer has to be part of the public and having multiple customers connected to say one system means the system is a public system).



At the time the invention was made it would have been obvious for one skilled in the art to modify the combined apparatuses of Ellis, Liebenow, Young, Herrod, and Pope using spread spectrum communication apparatus of McKenna for the purpose of having a secure transmission of information.

Referring to claim 2, depending on claim 1, Ellis teaches a said electronic apparatus comprises a portable terminal (Figure 2a and Figure 5 teach a portable terminal element 24 in Figure 2a).

Referring to claim 3, depending on claim 2, Ellis teaches wherein said portable terminal comprises a private apparatus (Figure 5 teaches the remote display device and the examiner views the remote display device element 24 to be private by means of communicating with a subscribers set-top box).

Referring to claim 4, depending on claim 1, Ellis teaches an apparatus having functions of recording and playing broadcast programs comprises an audio apparatus or a video apparatus (Figure 4 and paragraphs 88-91 teach element 22 a set-top box connected to display device 45).

Referring to claim 6, depending on claim 1, see rejection of claim 1.

Referring to claim 8, depending on claim 6, Ellis teaches wherein the short-distance wireless communication is based on an infrared data communication system (Paragraph 86 and Figure 4).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. 2005/0028208 A1) in view of Liebenow (U.S. 6601074 B1) further in view of Young et al. (U.S. 2005/0251836 A1) further in view of Herrod et al. (U.S. 6405049 B2) further in view of Pope (U.S. 5963624) further in view of McKenna et al. (U.S. 6594498 B1) further in view of Clapper (U.S. 6501516 B1).

Referring to claim 7, Ellis, Liebenow, Young, Herrod, Pope, and McKenna teach all the limitations in claim 6, except for wherein the short-distance wireless communication is based on the Bluetooth system.

In an analogous art Clapper teaches wherein the short-distance wireless communication is based on the Bluetooth system (Column 2 lines 24-26).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the combined apparatuses of Ellis, Liebenow, Young, Herrod, Pope, and McKenna using the Bluetooth protocol apparatus of Clapper for the purpose of transmitting a control signal between the remote control and the set-top box.

Claims 9-12 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowser (U.S. 6870570 B1) in view of Liebenow (U.S. 6601074 B1) further in view of Herrod et al. (U.S. 6405049 B2) further in view of Pope (U.S. 5963624) further in view of McKenna et al. (U.S. 6594498 B1).

Referring to claim 9, Bowser teaches a portable terminal for recording and playing broadcast programs (Figure 1 and Column 4 lines 26-32 teaches the user selection of a program on a PDA and it either being viewed/played or recorded by the VCR), comprising:

transmission means for transmitting program information stored in a database that stores the program information for broadcast programs (Figure 1 and Column 4 lines 13-21 teaches a STB/database that receives program information and can transmit it to a PDA) to an electronic apparatus using wireless communication (Figure 1 and Column 3 lines 66-67 and Column 4 lines 1-12);

display means for displaying the program information obtained using said transmission means (Column 4 lines 21-24 teaches reviewing program data on the PDA);

command transmission means for transmitting a command that controls recording and playing broadcast programs to a server that controls recording and playing performed by the apparatus (Column 4 lines 26-35 teaches instructing the VCR to record a program and Figure 1 teaches communication line element 16 goes through

element 4 a STB/server thus the STB controls the VCR which inherently has recording and playing capabilities and Column 3 lines 60-62 teaches an antenna is used to receive television signals which would have to be broadcasted)

Bowser fails to teach determination means for determining whether the selection information indicates information that has been recorded by the apparatus having functions or recording and playing broadcast programs;

switching means for switching a wireless communication unit between communication using a public circuit based on a spread spectrum communication system and short-distance wireless communication based on the spread spectrum communication systems.

In an analogous art Liebenow teaches determination means for determining whether the selection information indicates information that has been recorded by the apparatus having functions or recording and playing broadcast programs (Column 5 lines 26-45 and Figure 3 teaches the system checking recording information to determine if the program has been recorded or not).

At the time the invention was made it would have been obvious for one skilled in the art to modify the wireless remote system of Bowser with the determination of recorded information system of Liebenow for the purpose of freeing a user from having to research the contents of each episode of a program in order to determine whether has already recorded that particular episode and then having to selectively program his

system for each occurrence of the programs that he wishes to record (Column 2 lines 7-12, Liebenow).

Bowser and Liebenow fail to teach switching means for switching a wireless communication unit between communication using a public circuit based on a spread spectrum communication system and short-distance wireless communication based on the spread spectrum communication systems.

In an analogous art Herrod teaches switching means for switching a wireless communication unit between communication using a public circuit and short-distance wireless communication (Column 16 lines 20-30 and Column 39 lines 66-67 and Column 40 lines 1-5).

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined system of Bowser and Liebenow with the wireless switching between private and public networks system Herrod for the purpose of providing guaranteed communications no matter where the device is located in relation to the terminal (Column 16 lines 26-30, Herrod).

Bowser, Liebenow, and Herrod fail to teach using spread spectrum in a wireless public and short distance wireless communication system.

In an analogous art Pop teaches using spread spectrum in a short distance wireless communication system (Column 2 lines 52 – 57 teaches using spread spectrum communication to control appliances)

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined system of Bowser, Liebenow, and Herrod with the spread spectrum communication system of Pope for the purpose of being able to communicate from a different room and or a significant distance away from the base unit 12 (Column 3 lines 24-28).

Bowser, Liebenow, Herrod, and Pope fail to teach using spread spectrum in a wireless public communication system.

In an analogous art McKenna teaches using spread spectrum in a wireless public communication system (Column 5 lines 63-67, Column 6 lines 1-18, and Figure 1B teaches a wireless system using CDMA (which is a form of spread spectrum) and Column 3 lines 37-44 teaches multiple customers and a customer has to be part of the public and having multiple customers connected to say one system means the system is a public system).

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined system of Bowser, Liebenow, Herrod, and Pope using spread spectrum communication apparatus of McKenna for the purpose of having a secure transmission of information.

Referring to claim 10, depending on claim 9, Bowser teaches a portable terminal for recording and playing broadcast programs wherein said electronic apparatus

includes said portable terminal (The examiner is viewing this claim to mean the entire system includes an electronic device thus Figure 1 element 10 and Column 3 lines 66-67 and Column 4 lines 1-12 teaches the system comprising a PDA).

Referring to claim 11, depending on claim 10, Bowser teaches wherein said portable terminal comprises a private apparatus (Figure 1 and Column 3 lines 66-67 and Column 4 lines 1-12 teaches the system comprising a PDA which requires one individual to operate and the operation is done with relation to a home/private system).

Referring to claim 12, depending on claim 9, Bowser teaches an apparatus having functions of recording and playing broadcast programs comprises an audio apparatus or a video apparatus (Column 4 lines 12-35).

Referring to claim 14, depending on claim 9, see rejection of claim 9.

Referring to claim 15, depending on claim 14, Bowser teaches wherein the short-distance wireless communication is based on the Bluetooth system (Column 4 lines 1-12).

Referring to claim 16, depending on claim 14, Bowser teaches wherein the short-distance wireless communication is based on an infrared data communication system (Column 4 lines 1-12).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Related art Bjorndahl (U.S. 6901241 B2).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

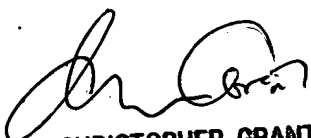
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter C. Wilder whose telephone number is 571-272-2826. The examiner can normally be reached on 8 AM - 4PM Monday - Friday.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571)272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PW



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